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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,493	07/21/2003	Hiroyuki Nagase	018995-735	4993

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EXAMINER

LE, HOA VAN

ART UNIT PAPER NUMBER

1752

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/622,493

Applicant(s)

NAGASE ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,7-10 and 27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3,7-10 and 27 with respect to the applied species is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/187,605.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

This is in response to Papers filed on 25 April 2006.

I. Claims 1-3, 7-10 and 27 with respect to the applied species are rejected under 35 U.S.C. 103(a) as being unpatentable over Lam (3,615,480) considered in view of Suzuki et al (5,532,116).

Lam discloses, teaches and suggests an alkaline aqueous developer comprising at least 0.5 wt% of potassium silicate having a ratio of silica oxide/alkali metal oxide from 2.0-1.0 and a nonionic surfactant and having a pH of 10-12. Please see the whole disclosure of each of the applied references, especially in Lam at col.2: 39-40, 55, 3:26-28, 49-58, 60 and 64-66, col.5:6-8 and 34-41, col.6:6-7, Bottom of cols.5 and 6 with "DEVELOPER SOLUTIONS AND pH VALUES" having "3" in day 1, 2 and 3, "4" in day 1, 2, 3 and 4, "5" in day 1, 2, 3, 4, 5 and 7, "6" in day 1, 2, 3 and 4 and claim 6.

Lam does not specify a naphthalene containing nonionic surfactant (I-B) with n being from 5 to 30 of the newly amended claim 1. Suzuki et al at col.9:28-30 and 39-42 is cited to shows the known use of the claim nonionic surfactant and its amount of up to 3 wt% for the advantage of obtaining stable compositions (col.2:34-49 and Table 1 on col.23).

Lam does not specify the functional language “has a conductivity...” in the instant claim 10. It has been considered but is reasonably inherent. Since the applied developers are shown to be same as those in the instant claims, they would inherently have the same or above the same functional property in the absence of convincing evidence to the contrary in accordance with the authority stated in *In re Schreiber*, 44 USPQ2d 1429.

Since the above references are all related to alkaline aqueous developers, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite an amount of the naphthalene containing nonionic surfactant from Suzuki et al in Lam alkaline aqueous developers for a reasonable expectation of obtaining stable compositions as disclosed, taught, suggested and obtained in Suzuki et al.

II. Applicant’s arguments filed on 25 April 2006 have been fully considered but are not found to be convincing.

The rejection on the record is not based up on impermissible use of hindsight because it does not depend up on any information that can be gleaned only from applicants’ application in accordance with the authority stated in *In re McLaughlin*, 170 USPQ 209.

Applicants recognize that Lam use Triton X-100 nonionic surfactant on col.5:6-8.

Nonionic surfactant C-2 having 4 ethoxy units is not applied in the above rejection but those having 5-30 ethoxy units are applied as disclosed, taught and suggested in Suzuki et al at col.9:28-30 and 39-42.

Applicants urge that there are conventionally additives in the applied references on the record. Therefore, the references are not combinable. There is no teaching or suggestion one or more conventional additives must be exclude from the primary reference with respect Lam (3,615,480). There is also no conventional additive being excluded from the instant claimed. At the level of one skilled in the art, one would use the combined teachings and suggestions in both of the applied references.

Applicants urge that there are some advantages in Table 2-6 of the specification for the use of the claimed naphthalene structure (general formula (I-B) nonionic surfactant. Since Suzuki et al disclose, teach, suggest, applied and reduced to practice with a naphthalene structure (general formula (I-B) nonionic surfactant as claimed, the same or about the same advantages would also be obtained.

At the level of one skilled in the art, it has a reason to believe that one having ordinary skill in the art at the time the invention was made to combine the teachings and suggestions of the above applied references.

There is no suggestion of the use of an anionic surfactant from Suzuki et al secondary reference on the record.

Other alkaline agents can also be seen in Lam at col.3:54-57 as some of those in the instant claim 8.

The showings in the specification have been once again carefully considered but have and are given little to no value in comparing with the broad embodiments in the claims with respect to numbers of the specifically tested chemical ingredients and their amounts of the tested chemical ingredients. Applicants fail to show tests be carried out with about 0.1 and 15 wt% of nonionic surfactant and about 0.1 and 3 wt% of a silicate as clearly and timely set forth on the record for closely determining an unusual or unexpected result for a patentability of the claims. There is nothing being unusual or unexpected result with respect to the narrowly showings. There are some improvements with respect to the narrowly showings. However, the instant claims have not been limited to the compositions containing all chemical ingredients and their amount as tested.

Points of allowability of the claims:

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(1) The claims must closely contain the tested compositions with respect to all chemical ingredients or their adjacent homologue and reasonably within + and – about 3% of their tested amount.

(2) The claims must contain the about suggested language “an improvement in printing more than 250,000 copies or sheets” or “the composition is suitable to print more than 250,000 copies or sheets” as shown on the record.

There is no patentable issue or improvement is found in printing or copying in less than 250,000 sheets or copies as shown on the record.

There is no patentable issue or improvement with even narrowly tested compositions. Therefore, no patentable issue or improvement is found in the broadly claim as urged.

III. Tanka et al (4,820,621) has about the same teachings and suggestions as those the above applied secondary reference with respect to Suzuki et al (5,532,116) and is cumulative but could be later applied.

IV. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

V. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332. The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available

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through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
09 May 2006

HOA VAN LE
PRIMARY EXAMINER

A handwritten signature in cursive script that reads "Hoa Van Le".